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BY FAX AND MAIL

March 29, 2002

Perry Clark, Esq.
Weil, Gotshal & Manges LLP
201 Redwood Shores Parkway
Redwood Shores, CA 94065

Re: Arthrocare Suit - Delaware
USDC-D: Del. - C.A. No. 01-504-SLR

FR
Dear Perry:

BOSTON
DALLAS
DELAWARE
NEW YORK
SAN DIEGO
SILICON VALLEY
TWIN CITIES
WASHINGTON, DC

Pursuant to the discussion during the discovery conference, I have enclosed Smith & Nephew's supplemental noninfringement and invalidity responses, which are subject to and made without waiving Smith & Nephew's previous objections to ArthroCare's discovery requests. We reserve the right to revise these responses as discovery proceeds. In particular, we reserve the right to revise these responses after we have received meaningful discovery on ArthroCare's claim construction and infringement contentions, and after the Court has construed the asserted claims.

Smith & Nephew objects to ArthroCare's improper attempts to informally amend its infringement allegations. Our responses concern (1) the Dyonics Control RF System which is the only product alleged in ArthroCare's Complaint to infringe and (2) the asserted claims originally identified in Jared Bobrow's November 2, 2001 letter. We are not providing responses at this time for the additional claims listed in your March 15 letter since that was the first notice we received, just two weeks ago, that those claims were being asserted. We are in the process of preparing responses to those additional claims, however, and expect to have them to you within the next two weeks.

In addition, and in response to your letter of March 27, 2002, we are also not providing responses at this time for the Dyonics Electroblade Resector ("Electroblade") since it is not in the case. As you know, Electroblade was not accused in ArthroCare's Complaint. The only product ArthroCare accused in its Complaint was the Dyonics Control RF System. Further, ArthroCare failed to move to amend its Complaint as it is required to do under the Rules, and the deadline for amending pleadings in this case expired on March 8, 2002. Instead, ArthroCare merely stated in a letter a week later that "Electroblade is now among the accused products."

As you know, the accusation of infringement in a patent lawsuit is a formal step in the case that carries with it certain burdens to investigate under Rule 11. *Judin v. United*

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States, 110 F.3d 780 (Fed. Cir. 1997); *Antonious v. Spalding & Evenflo Companies, Inc.*, 275 F.3d 1066 (Fed. Cir. 2002). Indeed, in light of ArthroCare's argument during the discovery conference on March 5 that it needed discovery to determine whether Electroblade infringes, we were quite surprised that Electroblade was included in ArthroCare's infringement chart. Accordingly, we question whether ArthroCare can meet its burden under Rule 11 with respect to Electroblade.

Please let me know if you are in disagreement with any of the foregoing.

Very truly yours,



Keith Walter

Smith & Nephew's Supplemental Response Re Non-Infringement

REDACTED

HIGHLY CONFIDENTIAL – ATTORNEYS' EYES ONLY

2. U.S. Patent No. 5,697,882 ("the '882 patent")

REDACTED

HIGHLY CONFIDENTIAL – ATTORNEYS' EYES ONLY

REDACTED

Smith & Nephew's Supplemental Response Re Invalidity

In addition to its previous objections, and without waiving any of those objections, Smith & Nephew also objects to providing its invalidity contentions at this time, since ArthroCare has refused to provide any of its contentions with respect to construction of the claims of its patents. Accordingly, Smith & Nephew reserves the right to supplement, amend, or otherwise modify its invalidity contentions as the case proceeds, and particularly after ArthroCare provides its proposed claim construction and/or after the Court construes the claims of ArthroCare's patents.

Nevertheless, as of the present time, Smith & Nephew incorporates its previous responses by reference, and further responds as follows:

Certain of Smith & Nephew's invalidity contentions are based on invalidity under 35 U.S.C. § 102 and/or § 103 in view of certain prior art references. In the interest of brevity and convenience, rather than repeat the full names of those references in connection with each such contention, Smith & Nephew will instead refer to those references by number, in accordance with the following table:

| # | Issue/ Pub'n Date | Patent Number/ Publication | Inventor/Author | Title |
|---|-------------------------|--|--|---|
| 1 | 08/16/33 | US 2,056,377 | F.C. Wappler | Electronic Instrument |
| 2 | 05/00/69 | Bio-Medical Engineering 206- 216 | A.K. Dobbie | The Electrical Aspects of Surgical Diathermy |
| 3 | 06/11/74 | US 3,815,604 | Conor C. O'Malley, Ralph M. Heintz, Sr. | Apparatus For Intraocular Surgery |
| 4 | 08/13/74 | US 3,828,780 | Charles F. Morrison, Jr. | Combined Electrocoagulator- Suction Instrument |
| 5 | 01/00/75 | IEEE Transactions On Biomedical Engineering | William M. Honig | The Mechanism of Cutting in Electrosurgery |

| # | Issue/Pub'n Date | Patent Number/Publication | Inventor/Author | Title |
|----|------------------|---|--|---|
| 6 | 08/26/75 | US 3,901,242 | Karl Storz | Electric Surgical Instrument |
| 7 | 11/18/75 | US 3,920,021 | Siegfried Hildebrandt | Coagulating Devices |
| 8 | 00/00/76 | Acta Medicotechnica (Medizinal-Markt), Vol. 24, No. 4, 1976.129 - 134 | E. Elsasser and E. Roos | Über ein Instrument zur leckstromfreien transurethralen Resection (Concerning An Instrument for Transurethral resection without leakage of current) |
| 9 | 02/24/76 | US 3,939,839 | Lawrence E. Curtiss | Resectoscope and Electrode Therefor |
| 10 | 07/20/76 | US 3,970,088 | Charles F. Morrison | Electrosurgical Devices Having Sesquipolar Electrode Structures Incorporated Therein |
| 11 | 01/07/77 | 2 313 949 / N 76 17587 | Siegfried Hildebrandt et Ludwig Bonnet | Boucle de sectionnement à une ou deux branches pour resertoscope |
| 12 | 00/00/78 | Gastroenterology, Vol. 74, No. 3, 527-534, 1978 | J.R.A. Piercy, M.D., D.C. Auth, Ph.D., P.E., F.E. Silverstein, M.D., H.R. Willard, Ph.D, M.B. Dennis, D.V.M., D.M. Ellefson, B.S., D.M. Davis, M.S.E.E., R.L. Protell, M.D. and C.E. Rubin, M.D. | Electrosurgical Treatment of Experimental Bleeding Canine Gastric Ulcers: Development and testing of a computer control and a better electrode |
| 13 | 02/21/78 | US 4,074,718 | Charles F. Morrison, Jr. | Electrosurgical Instrument |
| 14 | 06/06/78 | US 4,092,986 | Max Schneiderman | Constant Output Electrosurgical Unit |
| 15 | 09/26/78 | US 4,116,198 and its file history | Eberhard Roos | Electro-Surgical Device |
| 16 | 11/00/79 | Digestive Diseases and Sciences, Vol. 24, No. 11, 845-848 | M.B. Dennis, J. Peoples, R. Hulett, D.C. Auth, R.L. Protell, C.E. Rubin, and F.E. Silverstein | Evolution of Electrofulguration in Control of Bleeding of Experimental Gastric Ulcers |

| # | Issue/ Pub'n Date | Patent Number/ Publication | Inventor/Author | Title |
|----|-------------------------|--|---|--|
| 17 | 01/01/80 | US 4,181,131 | Hisao Ogiu | High Frequency Electrosurgical Instrument for Cutting Human Body Cavity Structures |
| 18 | 01/22/80 | US 4,184,492 | Hans H. Meinke, Gerhard Flachenecker, Karl Fastenmeier, Friedrich Landstorfer, Heinz Lidenmeier | Safety Circuitry for High Frequency Cutting and Coagulating Devices |
| 19 | 11/11/80 | US 4,232,676 | Andrew Herczog | Surgical Cutting Instrument |
| 20 | 02/03/81 | US 4,248,231 | Andrew Herczog and James A. Murphy | Surgical Cutting Instrument |
| 21 | 02/00/82 | CRC Press, American Heart Journal, Vol. 117, 332-341 | Kevin J. Barry, MS, Jonathan Kaplan, MD, Raymond J. Connolly, Ph.D, Paul Nardella, BS, Benjamin I. Lee, MD, Gary J. Becker, MD, Bruce F. Waller, MD, and Allan D. Callow, MD, Ph.D | The effect of radiofrequency-generated thermal energy on the mechanical and histologic characteristics of the arterial wall in vivo: Implications for radiofrequency angioplasty |
| 22 | 04/27/82 | US 4,326,529 | James D. Doss and Richard L. Hutson | Corneal-Shaping Electrode |
| 23 | 04/26/83 | US 4,381,007 | James D. Doss | Multipolar Corneal-Shaping Electrode with Flexible Removable Skirt |
| 24 | 00/00/84 | Gut, 25, 1424-1431 | C.P. Swain, TN Mills, E. Shemesh, Julia M. Dark, M.R. Lewin, J.S. Clifton, T.C. Northfield, P.B. Cotton, and P.R. Salmon | Which Electrode? A comparison of four endoscopic methods of electrocoagulation in experimental bleeding ulcers |

| # | Issue/ Pub'n Date | Patent Number/ Publication | Inventor/Author | Title |
|----|-------------------------|--|--|--|
| 25 | 00/00/85 | Urological Research 13:99-102 | J.W.A. Ramsay, N.A. Shepherd, M. Butler, P.T. Gosling, R.A. Miller, D.M.A. Wallace, H.N. Whitfield | A Comparison of Bipolar and Monopolar Diathermy Probes in Experimental Animals |
| 26 | 06/00/85 | JACC Vol. 5, No. 6, 1382-6 | Cornelis J. Slager, MSc, Catharina E. Essed, MD, Johan C.H. Schuurbiers, BSc, Nicolaas Bom, Ph.D, Patrick W. Serruys, MD, Geert T. Meester, MD, FACC | Vaporization of Atherosclerotic Plaques by Spark Erosion |
| 27 | 10/22/85 | US 4,548,207 | Harry G. Reimels | Disposable Coagulator |
| 28 | 05/27/86 | US 4,590,934 | Jerry L. Malis, Léonard J. Malis, Robert R. Acorcey, David Solt | Bipolar Cutter/Coagulator |
| 29 | 00/00/87 | Kardiologie, Kardiol. 76: Supp. 6, 67-71 (1987) | C.J. Slager, A.C. Phaff, C.E. Essed, J.C.H. Schuurbiers, N. Bom, V.A. Vandebroucke, and P.W. Serruys | Spark Erosion of Arteriosclerotic Plaques |
| 30 | 04/28/87 | US 4,660,571 | Stanley R. Hess, Terri Kovacs | Percutaneous Lead Having Radially Adjustable Electrode |
| 31 | 06/23/87 | US 4,674,499 | David S.C. Pao | Coaxial Bipolar Probe |
| 32 | 07/00/88 | Valleylab Part Number 945 100 102 A | Valleylab, Inc. | Surgistat Service Manual |
| 33 | 11/22/88 | US 4,785,823 | Philip E. Eggers, Robert F. Shaw | Methods And Apparatus For Performing In Vivo Blood Thermodilution Procedures |
| 34 | 00/00/89 | SPIE Vol. 1068 Catheter-based Sensing and Imaging Technology | Paul C. Nardella | Radio Frequency Energy and Impedance Feedback |

| # | Issue/ Pub'n Date | Patent Number/ Publication | Inventor/Author | Title |
|----|-------------------------|--|---|---|
| 35 | 00/00/89 | The Organizing Committee of the 7 th World Congress on Endourology and ESWL Foundation for Advancement of International Science | Robert Tucker and Stefan Loening | A Bipolar Electrosurgical Turp Loop |
| 36 | 02/21/89 | US 4,805,616. | David S.C. Pao | Bipolar Probes for Ophthalmic Surgery and Methods of Performing Anterior Capsulotomy |
| 37 | 03/00/89 | Journal of Urology Vol. 141, 662-665 | Robert D. Tucker, Eugène V. Kramolowsky, Eric Bedell and Charles E. Platz | A Comparison of Urologic Application of Bipolar Versus Monopolar Five French Electrosurgical Probes |
| 38 | 04/00/89 | JACC Vol. 13 No. 5, 1167-75 | Benjamin I. Lee, MD, FACC, Gary J. Becker, MD, Bruce F. Waller, MD, FACC, Kevin J. Barry, MS, Raymond J. Connolly, Ph.D, Jonathan Kaplan, MD, Alan R. Shapiro, MS, Paul C. Nardella, BS | Thermal Compression and Molding of Atherosclerotic Vascular Tissue With Use of Radiofrequency Energy: Implications for Radiofrequency Balloon Angioplasty |
| 39 | 04/25/89 | US 4,823,791 | Frank D. D'Amelio, Dawn M. DeLemos, Dominick G. Esposito, Michelle D. Maxfield, Claude E. Petrucci, Robert H. Quint | Electrosurgical Probe Apparatus |
| 40 | 05/23/89 | US 4,832,048 | Donald Cohen | Suction Ablation Catheter |
| 41 | 00/00/90 | Urological Research 18:291-294 | R.D. Tucker, E.V. Kramolowsky, and C.E. Platz | In vivo effect of 5 French bipolar and monopolar electrosurgical probes on the porcine bladder |

| # | Issue/ Pub'n Date | Patent Number/ Publication | Inventor/Author | Title |
|----|-------------------------|--------------------------------------|--|---|
| 42 | 02/00/90 | Journal of Urology Vol. 143, 275-277 | Eugene V. Kramolowsky and Robert D. Tucker | Use of 5F Bipolar Electrosurgical Probe in Endoscopic Urological Procedures |
| 43 | 04/05/90 | WO 90/03152 | John Considine, John Colin | Electro-surgical Apparatus for Removing Tumours from Hollow Organs of the Body |
| 44 | 05/01/90 | US 4,920,978 | David P. Colvin | Method and Apparatus for the Endoscopic Treatment of Deep Tumors Using RF Hyperthermia |
| 45 | 06/05/90 | US 4,931,047 | Alan Broadwin, Charles Vassallo, Joseph N. Logan, Robert W. Hornlein | Method and Apparatus For Providing Enhanced Tissue Fragmentation And/Or Hemostasis |
| 46 | 06/26/90 | US 4,936,281 | Peter Stasz | Ultrasomically Enhanced RF Ablation Catheter |
| 47 | 10/30/90 | US 4,966,597 | Eric R. Cosman | Thermometric Cardiac Tissue Ablation Electrode with Ultra-Sensitive Temperature Detection |
| 48 | 12/11/90 | US 4,976,711 | David J. Parins, Mark A. Rydell, Peter Stasz | Ablation Catheter With Selectively Deployable Electrodes |
| 49 | 12/25/90 | US 4,979,948 | Lesslie A. Geddes, Marvin H. Hinds, Joe D. Bourland, William D. Voorhees | Method and Apparatus for Thermally Destroying A Layer of An Organ |
| 50 | 03/21/91 | DE 3930451 A1 | Ellen Hoffmann, Gerhard Steinbeck, Rudi Mattmuller | Vorrichtung für die Hochfrequenzkoagulation von biologischem Gewebe |
| 51 | 04/16/91 | US 5,007,908 | Mark A. Rydell | Electrosurgical Instrument Having Needle Cutting Electrode And Spot-Coag Electrode |
| 52 | 04/23/91 | US 5,009,656 | Harry G. Reimels | Bipolar Electrosurgical Instrument |
| 53 | 07/30/91 | US 5,035,696 | Mark A. Rydell | Electrosurgical Instrument for Conducting Endoscopic Retrograde Sphincterotomy |

| # | Issue/ Pub'n Date | Patent Number/ Publication | Inventor/Author | Title |
|----|-------------------------|--|---|---|
| 54 | 09/00/91 | Journal of Urology Vol. 146, 669 | Eugene V. Kramolowsky and Robert D. Tucker | The Urological Application of Electrosurgery |
| 55 | 09/10/91 | US 5,047,026 | Mark A. Rydell | Electrosurgical Implement For Tunneling Through Tissue |
| 56 | 09/10/91 | US 5,047,027 | Mark A. Rydell | Tumor Resector |
| 57 | 10/07/91 | Bipolar Laparoscopic Cholecystectomy Lecture | Dr. Olsen | Bipolar Laparoscopic Cholecystectomy |
| 58 | 01/14/92 | US 5,080,660 | Terrence J. Buelna | Electrosurgical Electrode |
| 59 | 01/28/92 | US 5,084,044 | Robert H. Quint | Apparatus for Endometrial Ablation and Method of Using Same |
| 60 | 02/04/92 | US 5,085,659 | Mark A. Rydell | Biopsy Device With Bipolar Coagulation Capability |
| 61 | 02/18/92 | US 5,088,997 | Louis Delahuerga, Robert B. Stoddard, Michael S. Klicek | Gas Coagulation Device |
| 62 | 03/24/92 | US 5,098,431 | Mark A. Rydell | RF Ablation Catheter |
| 63 | 04/28/92 | US 5,108,391 | Gerhard Flachenecker, Karl Fastenmeier, Heinz Lindenmeier | High-Frequency Generator For Tissue Cutting And For Coagulating In High-Frequency Surgery |
| 64 | 05/12/92 | US 5,112,330 | Shinichi Nishigaki, Shiro Bito | Resectoscope Apparatus |
| 65 | 06/16/92 | US 5,122,138 | Kim H. Manwaring | Tissue Vaporizing Accessory and Method for an Endoscope |
| 66 | 12/01/92 | US 5,167,659 | Naoki Ohfomo; Shizuo Ninomiya | Blood Coagulating Apparatus |
| 67 | 12/15/92 | US 5,171,311 | Mark A. Rydell, David J. Parins, Steven W. Berhow | Percutaneous Laparoscopic Cholecystectomy Instrument |
| 68 | 03/30/93 | US 5,197,963 | David J. Parins | Electrosurgical Instrument with Extendable Sheath for Irrigation and Aspiration |
| 69 | 05/04/93 | US 5,207,675 | Jerome Canady | Surgical Coagulation Device |

| # | Issue/ Pub'n Date | Patent Number/ Publication | Inventor/Author | Title |
|----|-------------------------|-------------------------------|---|---|
| 70 | 06/08/93 | US 5,217,459 | William Kamerling | Method and Instrument for Performing Eye Surgery |
| 71 | 04/26/94 | US 5,306,238 | Richard P. Fleenor | Laparoscopic Electrosurgical Pencil |
| 72 | 06/13/95 | US 5,423,882 | Warren M. Jackman, Wilton W. Webster, Jr. | Catheter Having Electrode With Annular Recess and Method of Using Same |
| 73 | 10/03/95 | US 5,454,809 | Michael Janssen | Electrosurgical Catheter And Method For Resolving Artherosclerotic Plaque By Radio Frequency Sparking |

1. U.S. Patent No. 5,697,536 ("the '536 patent")

A. Claim 45

Smith & Nephew contends that claim 45 of the '536 patent is anticipated by at least each of the following references: 3, 8, 12, 15, 16, 18, 19, 20, 21, 22, 23, 24, 25, 26, 27, 28, 29, 31, 33, 35, 36, 37, 38, 41, 42, 43, 45, 46, 48, 49, 51, 52, 53, 54, 57, 61, 63, 65, 66, 67, 69, 70, 71.

Smith & Nephew also contends that claim 45 of the '536 patent would have been obvious to one of ordinary skill in the art at the time of the invention in view of at least each of the following combinations of references, which Smith & Nephew contends would have been combined for at least the following reasons:

| Combination | Motivation to Combine |
|---|---|
| Any one or more of 1, 4, 5, 6, 7, 9, 10, 11, 13, 16, 17, 20, 30, 33, 39, 40, 44, 50, 55, 56, 58, 60, 61, 62, 64, 68, 69, 71, 72, 73 with any one or more of 35, 54, 57. | Each reference is directed to the same problem – applying electrical energy to a target site on a patient's body structure. |
| Any one or more of 1, 4, 5, 6, 7, 9, 10, 11, 13, 16, 17, 20, 30, 33, 39, 40, 44, 50, 55, 56, 58, 60, 61, 62, 64, 68, 69, 71, 72, 73 with any other one or more of the anticipating references listed above. | Each reference is directed to the same problem – applying electrical energy to a target site on a patient's body structure. |

| Combination | Motivation to Combine |
|---|---|
| Any one or more of 35, 54, 57 with 59. | Each reference is directed to the same problem – applying electrical energy to a target site on a patient's body structure. |
| Any one or more of 35, 54, 57 with any other one or more of the anticipating references listed above. | Each reference is directed to the same problem – applying electrical energy to a target site on a patient's body structure. |
| Any one or more of 2, 34, 47 with any one or more of the anticipating references listed above. | Each reference is directed to the same problem – applying electrical energy to a target site on a patient's body structure. |
| 59 with any one or more of the anticipating references listed above. | Each reference is directed to the same problem – applying electrical energy to a target site on a patient's body structure. |

2. U.S. Patent No. 5,697,882 ("the 882 patent")

A. Claim 1

Smith & Nephew contends that claim 1 of the '882 patent is anticipated by at least each of the following references: 2, 3, 5, 8, 15, 16, 18, 22, 23, 24, 25, 26, 27, 28, 29, 30, 31, 34, 35, 36, 37, 38, 42, 45, 46, 48, 49, 51, 52, 53, 54, 55, 57, 61, 62, 63, 65, 66, 67, 68, 71, 73.

Smith & Nephew also contends that claim 1 of the '882 patent would have been obvious to one of ordinary skill in the art at the time of the invention in view of at least each of the following combinations of references, which Smith & Nephew contends would have been combined for at least the following reasons:

| Combination | Motivation to Combine |
|---|---|
| Any one or more of 1, 6, 7, 9, 11, 17, 30, 39, 40, 44, 47, 50, 55, 56, 58, 61, 62, 64, 68, 69, 71, 73 with any other one or more of the anticipating references listed above. | Each reference is directed to the same problem – applying electrical energy to a target site on a patient's body structure. |

| Combination | Motivation to Combine |
|---|---|
| Any one or more of 1, 6, 7, 9, 11, 17, 30, 39, 40, 44, 47, 50, 55, 56, 58, 61, 62, 64, 68, 69, 71, 73 with any one or more of 2, 3, 4, 12, 16, 18, 21, 22, 23, 24, 25, 27, 28, 31, 33, 34, 35, 36, 37, 41, 42, 43, 45, 46, 48, 49, 51, 53, 54, 57, 60, 63, 66, 67, 70, 72 and with any one or more of 10, 13. | Each reference is directed to the same problem – applying electrical energy to a target site on a patient's body structure. |
| Any one or more of 2, 3, 4, 12, 16, 18, 21, 22, 23, 24, 25, 27, 28, 31, 33, 34, 35, 36, 37, 41, 42, 43, 45, 46, 48, 49, 51, 53, 54, 57, 60, 63, 66, 67, 70, 72 with any other one or more of the anticipating references listed above. | Each reference is directed to the same problem – applying electrical energy to a target site on a patient's body structure. |
| Any one or more of 2, 3, 4, 12, 16, 18, 21, 22, 23, 24, 25, 27, 28, 31, 33, 34, 35, 36, 37, 41, 42, 43, 45, 46, 48, 49, 51, 53, 54, 57, 60, 63, 66, 67, 70, 72 with any one or more of 10, 13. | Each reference is directed to the same problem – applying electrical energy to a target site on a patient's body structure. |
| Any one or more of 10, 13 with any other one or more of the anticipating references listed above. | Each reference is directed to the same problem – applying electrical energy to a target site on a patient's body structure. |

Smith & Nephew further contends that claim 1 of the '882 patent is also invalid as indefinite under 35 U.S.C. § 112 ¶ 2.

B. Claim 26

Smith & Nephew contends that claim 26 of the '882 patent is anticipated by at least each of the following references: 2, 5, 23, 26, 29, 61, 63.

Smith & Nephew also contends that claim 26 of the '882 patent would have been obvious to one of ordinary skill in the art at the time of the invention in view of at least each of the following combinations of references, which Smith & Nephew contends would have been combined for at least the following reasons:

| Combination | Motivation to Combine |
|---|---|
| Any one or more of 1, 6, 7, 10, 11, 13, 17, 30, 39, 40, 44, 47, 50, 55, 56, 58, 62, 64, 68, 69, 71, 73 with any one or more of 3, 4, 8, 12, 15, 16, 18, 21, 22, 23, 24, 25, 27, 28, 31, 33, 34, 35, 36, 37, 38, 41, 42, 43, 45, 46, 48, 49, 51, 52, 53, 54, 57, 60, 65, 66, 67, 70, 72 and with any one or more of 9, 14, 32, 61. | Each reference is directed to the same problem – applying electrical energy to a target site on a patient's body structure. |
| Any one or more of 1, 6, 7, 10, 11, 13, 17, 30, 39, 40, 44, 47, 50, 55, 56, 58, 62, 64, 68, 69, 71, 73 with any one or more of the anticipating references listed above. | Each reference is directed to the same problem – applying electrical energy to a target site on a patient's body structure. |
| Any one or more of 3, 4, 8, 12, 15, 16, 18, 21, 22, 24, 25, 27, 28, 31, 33, 34, 35, 36, 37, 38, 41, 42, 43, 45, 46, 48, 49, 51, 52, 53, 54, 57, 60, 65, 66, 67, 70, 72 with any one or more of 9, 14, 32, 61. | Each reference is directed to the same problem – applying electrical energy to a target site on a patient's body structure. |
| Any one or more of 3, 4, 8, 12, 15, 16, 18, 21, 22, 24, 25, 27, 28, 31, 33, 34, 35, 36, 37, 38, 41, 42, 43, 45, 46, 48, 49, 51, 52, 53, 54, 57, 60, 65, 66, 67, 70, 72 with any one or more of the anticipating references listed above. | Each reference is directed to the same problem – applying electrical energy to a target site on a patient's body structure. |
| Any one or more of 9, 14, 32, 61 with any one or more of the anticipating references listed above. | Each reference is directed to the same problem – applying electrical energy to a target site on a patient's body structure. |

Smith & Nephew further contends that claim 26 of the '882 patent is also invalid as indefinite under 35 U.S.C. § 112 ¶ 2.

C. Claim 28

Smith & Nephew contends that claim 28 of the '882 patent is anticipated by at least each of the following references: 8, 15, 21, 26, 29, 41, 42, 45, 57.

Smith & Nephew also contends that claim 28 of the '882 patent would have been obvious to one of ordinary skill in the art at the time of the invention in view of at least each of the following combinations of references, which Smith & Nephew contends would have been combined for at least the following reasons:

| Combination | Motivation to Combine |
|--|---|
| Any one or more of 1, 6, 7, 9, 10, 11, 13, 17, 30, 39, 40, 47, 50, 55, 56, 58, 62, 64, 68, 69, 71, 73 with any one or more of 2, 3, 4, 5, 12, 16, 18, 19, 20, 22, 23, 24, 25, 27, 28, 31, 33, 34, 35, 36, 37, 38, 43, 46, 48, 49, 51, 52, 53, 54, 60, 63, 65, 66, 67, 70, 72 and with any one or more of 44, 61. | Each reference is directed to the same problem – applying electrical energy to a target site on a patient's body structure. |
| Any one or more of 1, 6, 7, 9, 10, 11, 13, 17, 30, 39, 40, 47, 50, 55, 56, 58, 62, 64, 68, 69, 71, 73 with any one or more of the anticipating references listed above. | Each reference is directed to the same problem – applying electrical energy to a target site on a patient's body structure. |
| Any one or more of 2, 3, 4, 5, 12, 16, 18, 19, 20, 22, 23, 24, 25, 27, 28, 31, 33, 34, 35, 36, 37, 38, 43, 46, 48, 49, 51, 52, 53, 54, 60, 63, 65, 66, 67, 70, 72 with any one or more of the anticipating references listed above. | Each reference is directed to the same problem – applying electrical energy to a target site on a patient's body structure. |
| Any one or more of 2, 3, 4, 5, 12, 16, 18, 19, 20, 22, 23, 24, 25, 27, 28, 31, 33, 34, 35, 36, 37, 38, 43, 46, 48, 49, 51, 52, 53, 54, 60, 63, 65, 66, 67, 70, 72 with any one or more of 44, 61. | Each reference is directed to the same problem – applying electrical energy to a target site on a patient's body structure. |
| Any one or more of 44, 61 with any one or more of the anticipating references listed above. | Each reference is directed to the same problem – applying electrical energy to a target site on a patient's body structure. |

Smith & Nephew further contends that claim 28 of the '882 patent is also invalid as indefinite under 35 U.S.C. § 112 ¶ 2.

3. U.S. Patent No. 6,224,592 ("the '592 patent")

A. Claim 1

Smith & Nephew contends that claim 1 of the '592 patent is anticipated by at least each of the following references: 8, 15, 23, 26, 30, 31, 33, 34, 46, 48, 51, 52, 62, 72.

Smith & Nephew also contends that claim 1 of the '592 patent would have been obvious to one of ordinary skill in the art at the time of the invention in view of at least

each of the following combinations of references, which Smith & Nephew contends would have been combined for at least the following reasons:

| Combination | Motivation to Combine |
|--|---|
| Any one or more of 1, 6, 7, 9, 10, 11, 13, 17, 30, 39, 40, 44, 47, 50, 55, 56, 58, 62, 64, 68, 69, 71, 73 with any one or more of the other anticipating references listed above. | Each reference is directed to the same problem – applying electrical energy to a target site on a patient's body structure. |
| Any one or more of 1, 6, 7, 9, 10, 11, 13, 17, 30, 39, 40, 44, 47, 50, 55, 56, 58, 62, 64, 68, 69, 71, 73 with any one or more of 2, 3, 4, 5, 12, 16, 18, 20, 21, 22, 24, 25, 27, 28, 29, 31, 33, 34, 35, 36, 37, 38, 41, 42, 43, 45, 49, 53, 54, 57, 60, 61, 63, 65, 66, 67, 70, 72 and with any one or more of the other anticipating references listed above. | Each reference is directed to the same problem – applying electrical energy to a target site on a patient's body structure. |
| Any one or more of 2, 3, 4, 5, 12, 16, 18, 20, 21, 22, 24, 25, 27, 28, 29, 31, 33, 34, 35, 36, 37, 38, 41, 42, 43, 45, 49, 53, 54, 57, 60, 61, 63, 65, 66, 67, 70, 72 with any one or more of the other anticipating references listed above. | Each reference is directed to the same problem – applying electrical energy to a target site on a patient's body structure. |

Smith & Nephew further contends that claim 1 of the '592 patent is also invalid as indefinite under 35 U.S.C. § 112 ¶ 2.

B. Claim 23

Smith & Nephew contends that claim 23 of the '592 patent is anticipated by at least each of the following references: 8, 15, 26, 30, 34, 46, 48, 51, 62, 72.

Smith & Nephew also contends that claim 23 of the '592 patent would have been obvious to one of ordinary skill in the art at the time of the invention in view of at least each of the following combinations of references, which Smith & Nephew contends would have been combined for at least the following reasons:

| Combination | Motivation to Combine |
|---|---|
| Any one or more of 4, 5, 12, 16, 24, 25, 31, 36, 37, 38, 41, 42, 53, 61, 63, 65, 66, 67, 70, 72 with any one or more of the other anticipating references listed above. | Each reference is directed to the same problem – applying electrical energy to a target site on a patient's body structure. |
| Any one or more of 2, 3, 18, 19, 20, 21, 22, 23, 27, 28, 29, 33, 34, 35, 43, 45, 49, 52, 54, 57, 60 with any one or more of the other anticipating references listed above. | Each reference is directed to the same problem – applying electrical energy to a target site on a patient's body structure. |
| Any one or more of 2, 3, 18, 19, 20, 21, 22, 23, 27, 28, 29, 33, 34, 35, 43, 45, 49, 52, 54, 57, 60 with any one or more of 1, 7, 10, 17, 44, 55, 56 and any one or more of the other anticipating references listed above. | Each reference is directed to the same problem – applying electrical energy to a target site on a patient's body structure. |
| Any one or more of 2, 3, 18, 19, 20, 21, 22, 23, 27, 28, 29, 33, 34, 35, 43, 45, 49, 52, 54, 57, 60 with 59 and any one or more of the other anticipating references listed above. | Each reference is directed to the same problem – applying electrical energy to a target site on a patient's body structure. |
| Any one or more of 1, 7, 10, 17, 44, 55, 56 with any one or more of the other anticipating references listed above. | Each reference is directed to the same problem – applying electrical energy to a target site on a patient's body structure. |
| Any one or more of 6, 9, 11, 13, 30, 39, 40, 47, 50, 58, 62, 64, 68, 69, 71, 73 with any one or more of the other anticipating references listed above. | Each reference is directed to the same problem – applying electrical energy to a target site on a patient's body structure. |
| Any one or more of 6, 9, 11, 13, 30, 39, 40, 47, 50, 58, 62, 64, 68, 69, 71, 73 with 59 and any one or more of the other anticipating references listed above. | Each reference is directed to the same problem – applying electrical energy to a target site on a patient's body structure. |
| 59 with any one or more of the other anticipating references listed above. | Each reference is directed to the same problem – applying electrical energy to a target site on a patient's body structure. |

4. All Patents

Smith & Nephew also contends that the asserted claims of the '536, '882 and '592 patents are also invalid under 35 U.S.C. § 102(f) and/or § 116 because of improper inventorship.

Smith & Nephew's investigation into its defenses is continuing, and it reserves the right to assert additional invalidity defenses as discovery progresses.

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